

REMARKS

In the present Office Action, claims 1-21 were pending. Claims 1, 7, 13, and 17 were the independent claims. Claims 1-21 were rejected and claims 13-21 were objected to. In addition, the Office Action objects to the specification.

Herein, claims 1, 5, 7, 11, 12, 13, 15, 17, 19, and 21 are amended. No new claims are added. No new matter is provided. In addition, the specification is amended.

Acceptance of submitted drawings

In the Office Action, the Examiner indicates that the drawings submitted on August 7th, 2003 are accepted. Applicants appreciate the indication that said drawings are accepted.

Objection to the specification

The Office Action objects to the abstract of the disclosure. The Office Action states that the abstract of the present invention fails to comply with proper language and format. (Office Action, page 2).

The Applicants submit an amended abstract herein. However, in doing so, Applicants do not agree with the assertion that the as filed abstract does not comply with proper language and format. Applicants have amended the abstract for the sole purpose of expediting prosecution.

Objections to claims 13-21

In the Office Action, claims 13-21 were objected to. The Office Action states that claims 13, 15, 17, 19, and 21 in passim recite: "adapted to..." (page 2). The Office Action asserts that it has been held that the recitation that an

element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform and it does not constitute a limitation in any patentable sense. Applicants respectfully traverse the objections to claims 13-21.

Applicants respectfully submit that they do not agree with, nor accept the Examiner's assertion that "adapted to" does not introduce a positive limitation. The Examiner is respectfully reminded that MPEP Section 2173.05(g) makes it clear that functional claim language is perfectly acceptable. In fact, the MPEP includes an example of functional language introduced by the term "adapted to":

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' ... serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).
(emphasis added)

Accordingly, Applicants believe the phrase "adapted to" constitutes a positive recitation of a feature. However, solely to expedite prosecution, Applicants have amended the claims to replace "adapted to" with "operative to" which clearly positively recites a feature with patentable weight.

Rejections under 35 U.S.C. §102(b)

The Office Action rejects claims 1-5, 7-11, and 13-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,781,488 (Liu et al.). (page 3). Claims 1, 7, 13, and 17 are the only pending independent claims.

The independent claims have been amended to include additional features which Applicants assert overcome the

rejection. More specifically, the independent claims have been amended to include the features of "during an ABIST test". For example, (amended) claim 1 includes:

... selecting a bit during an ABIST test from each of a plurality of memory arrays formed on an IC chip ...

Independent claims 7, 13, and 17 have been similarly amended. Applicants submit that such features are not taught or suggested by Liu et al. More specifically, as the Office Action appears to concede on page 5, Liu et al. does not appear to teach or suggest an ABIST test. Accordingly, Applicants assert that the independent claims as amended are allowable under 35 U.S.C. §102(b) over Liu et al.

Rejections of claims under 35 U.S.C. 103(a)

The Office Action rejected claims 6 and 12 under 35 U.S.C. 103(a) as being unpatentable over Liu et al. in view of U.S. Patent No. 6,853,597 (Jain) filed September 26, 2002. Applicants assert that independent claims 6 and 12 are patentable under 35 U.S.C. §103(a).

Applicants respectfully submit that, despite the Examiner's assertion to the contrary, one of ordinary skill would not have been motivated to combine the Liu and Jain references to derive the Applicants' invention. In fact, Liu et al. appears to teach away from the present invention. Liu et al. states that a "feature of this invention is that the **multiplexer** needed in prior art to select between the two arrays **is eliminated**, and as such the time delay through the I/O data path is improved by removing the gate delay associated with the multiplexer." (Liu et al., column 4, lines 52-56). Thus, Lui teaches away from a test circuit that selects between memory

array outputs as recited in Applicants' claims. As indicated above, it is an object of the Lui reference to avoid having to select between arrays. Therefore, one would not have been motivated to combine Lui with Jain to reach Applicants' claimed invention and Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection based on Liu et al. in view of Jain.

Conclusion

Accordingly, since claims 2-6, 8-12, 14-16, and 18-21 depend from the asserted allowable independent claims 1, 7, 13, and 17, Applicants assert all claims are now allowable under both 35 U.S.C. §102(b) and 35 U.S.C. §103(a). Applicants believe the claims are now in condition for allowance, and respectfully request reconsideration and allowance of the same.

A separate Request for Extension of Time is enclosed herewith, with authorization to charge the requisite extension fee to deposit account no. 04-1696. Please charge Deposit Account No. 04-1696 for any other fees required by this Amendment. The Applicants encourage the Examiner to telephone Applicants' attorney should any questions remain.

Respectfully Submitted,



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